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Paper No. 6

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NOV 14 2002

**OFFICE OF PETITIONS**

In re Application of :  
John K. Brixius, James G. Schaadd, David W. George, :  
and Robert J. Dent :  
Application No. 10/043,554 : **DECISION ON PETITION**  
Filed: January 11, 2002 :  
Attorney Docket No. 3499-097 :  
Title: METHOD AND SYSTEM FOR VENTURE :  
CAPITALIST DISTRIBUTION OF STOCK :

This is in response to the petition under 37 C.F.R. §1.47(a)<sup>1</sup>, filed August 19, 2002<sup>2</sup>.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.47(a)."

On January 11, 2002, the application was deposited, identifying John K. Brixius, James G. Schaadd, David W. George, and Robert J. Dent as joint inventors. The application was deposited without a fully executed oath or declaration. On February 11, 2002, a "Notice to File Missing Parts of Nonprovisional Application – Filing Date Granted" (Notice) was mailed, indicating that an executed oath or declaration and a surcharge of \$130.00 were required. This Notice set a two-month period for reply.

<sup>1</sup>A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application;
- (3) a statement of the last known address of the non-signing inventors;
- (4) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review;
- (5) proof that the non-signing inventor refuses to sign the oath or declaration after having been presented with the application papers if the inventor refuses to sign, or proof that diligent efforts have been made to locate the non-signing inventor if he or she cannot be found, and;
- (6) a declaration which complies with 37 CFR §1.63.

<sup>2</sup> The petition contains a certificate of mailing dated August 8, 2002.

With the instant petition, the petitioner has included the filing fee for the petition, the \$65.00 surcharge, a four month extension of time to make timely this reply, a declaration<sup>3</sup> executed by inventors Brixius, George, and Dent, and a statement from an employee of the assignee.

Petitioner has met requirements (1), (2), (3) and (6) of 37 C.F.R. §1.47(a) above.

Regarding the fourth requirement, petitioner has not shown that a *complete* copy of the application was sent to the non-signing inventor. The statement of Ms. Carbone establishes that a copy of the declaration and power of attorney were sent to non-signing inventor Schaad<sup>4</sup>. As copies of the specification, claims, and drawings were not mailed to non-signing inventor Schaad, petitioner has not met this requirement.

Regarding the fifth requirement above, it follows that since it has not been shown that a complete copy of the application was sent to the inventor, one cannot refuse to sign something which one has not seen. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed<sup>5</sup>.

In light of the recent events, the USPTO **strongly** prefers that the reply to this letter be submitted by facsimile<sup>6</sup>. However, if applicant cannot submit the reply to this letter by facsimile (or hand-delivery<sup>7</sup>), the reply may be mailed<sup>8</sup>.

**The application file will be retained in the Office of Petitions for two (2) months.**

**Notice regarding fees:**

Historically the fees that the USPTO charges for doing business increase at the beginning of each fiscal year (October 1). However, no final determination has been made on fees for FY03 at this point, and fiscal year 2003 was started with the same fee structure as last fiscal year.

Please be advised that applicants should monitor the USPTO website for future updates whenever any necessary money is sent.

For more information, see [www.USPTO.gov](http://www.USPTO.gov), click on "News and Notices", and under the "Patents" column you will find the above information<sup>9</sup>.

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3 It is noted that the unexecuted declaration submitted with the application upon filing listed 9 joint inventors, whereas the declaration submitted with the instant petition lists only 4. As inventorship is set by the first executed declaration, inventors Bell, Weber, Shokina, Detwiler, and Dodwell are not considered joint inventors. If petitioners wish to add them, a petition under 37 CFR 1.48 will need to be filed.

4 The statement of facts states that a copy of this request was included as an attachment to the petition, but no such attachment has been located in the file.

5 *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

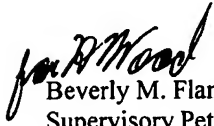
6 (703) 308-6916, Attn: Office of Petitions.

7 Office of Petitions, 2201 South Clark Place, Crystal Plaza 4, Suite 3C23, Arlington, VA 22202.

8 Commissioner for Patents, Box DAC, Washington, DC 20231.

9 The direct URL is: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/feenotice.htm>

Telephone inquiries should be directed to Petitions Attorney Paul Shanowski at (703) 305-0011.

A handwritten signature in black ink, appearing to read "Beverly M. Flanagan", is positioned to the left of the printed name.

Beverly M. Flanagan  
Supervisory Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy